

Appl. No. 09/322,259
Amendment/Response
Reply to Office Action of
January 16, 2004

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REMARKS/DISCUSSION OF ISSUES

Claims 1-16 are pending in the application. Claims 1,5,9 and 13 are the independent claims.

Rejections Under 35 U.S.C. § 103

The Office rejects claims 1-16 under 35 U.S.C. § 103(a) as being unpatentable over Tzeng (U.S. Patent 5,293,449) in view of DeJaco (U.S. Patent 6,484,138), further in view Su (U.S. Patent 5,664,054). For at least the reasons set forth below, it is respectfully submitted that this rejection is improper and should be withdrawn.

The establishment of a *prima facie* case of obviousness requires that all of the elements be found in the prior art. It follows, therefore, if a single element is not found in the prior art, a *prima facie* case of obviousness cannot properly be established. Moreover, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is a teaching, suggestion or motivation to do so found in the references relied upon. However, hindsight is never an appropriate motivation for combining references and/or the requisite knowledge available to one having ordinary skill in the art. To this end, relying upon hindsight knowledge of applicants' disclosure when the prior art does not teach nor suggest such knowledge results in the use of the invention as a template for its own reconstruction. This is wholly improper in the determination of patentability.

Claims 1, 5, 9 and 13 each feature that provided an input

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signal is received having an energy value lower than an input energy threshold value "...the input signal comprises a plurality of subframes, the subframes encoded at half-rate or greater..."

It is respectfully submitted that the applied art lacks at least the disclosure of this feature of the independent claims. The Office Action concedes that the reference to Tzeng lacks the disclosure of subframes encoded at different rates. The Office Action then relies on the reference to DeJaco to attempt to cure this deficiency in Tzeng. (Kindly refer to page 3 of the Office Action.) However, and as the Office Action describes, the reference to DeJaco discloses encoding **speech as quarter rate unvoiced**. Therefore, DeJaco does not disclose that the **subframes** are encoded at a **half-rate or greater**, as specifically featured in claims 1,5,9 and 13. (Kindly refer to column 2, line 59-column 3, line 7 of DeJaco for support for this assertion.)

For at least the reasons set forth above, it is respectfully submitted that the applied art lacks at least the disclosure of one of the features of independent claims 1,5,9 and 13. Therefore, these claims and the claims that depend therefrom are patentable over the applied art for at least the reasons set forth above. Allowance is earnestly solicited.

While the pending claims are allowable for at least the reasons set forth above, Applicants also respectfully traverse the propriety of the present rejection for additional reasons. To wit, it is submitted that the Office Action attempts to fabricate a patchwork mosaic of various pieces of prior art based on Applicants' teachings. Not only do the disclosures of

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the applied art lack at least the features of the claims as discussed above, it is submitted that the requisite motivation to combine the references is not provided. For example, the Office Action merely asserts that the applied reference to Su merely cures a deficiency of DeJaco, but does not provide any motivation as to why Su and DeJaco may be combined.

Accordingly, for at least this reason Applicants respectfully submit that the present rejection is improper and should be withdrawn.

Conclusion

In view of the foregoing, it is respectfully requested that all objections and rejections be withdrawn. Allowance of all pending claims is earnestly solicited.

In the event that there are any outstanding matters remaining in the present application, the Examiner is invited to contact William S. Francos, Esq. (Reg. No. 38,456) at (610) 375-3513 to discuss these matters.

If necessary, the Commissioner is hereby authorized in this, concurrent, and further replies to charge payment or credit any overpayment to Deposit Account Number 50-0238 for any additional fees, including, but not limited to those fees provided under 37 C.F.R. \$1.16 or under 37 C.F.R. \$1.17.

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Respectfully submitted on behalf of:

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April 16, 2004

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